

REMARKS

Summary

Claims 1-39 stand in this application. Claims 1, 4, 6, 10, 13, 18, 29, 31, 32 and 38 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 4, 6, 10, 13, 18, 29, 31, 32 and 38 in order to facilitate prosecution on the merits.

35 U.S.C. § 112

Claim 31 has been rejected under 35 U.S.C. § 112 for not particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. Applicant respectfully traverses the rejection based on the above amendments. This claim has been amended in accordance with the Office Action, and removal of this rejection is respectfully requested. Applicant further submits that the above amendments are made to overcome a § 112 rejection and are not made to overcome the cited references. Accordingly, these amendments should not be construed in a limiting manner.

35 U.S.C. § 102

At page 2, paragraph 2 of the Office Action claims 1, 3, 4, 6, 7, 9-11, 18, 19, 22-25, 27, 29, 30 and 38 stand rejected under 35 U.S.C. § 102 as being anticipated by United States Patent Number (USPN) 6,631,141 to Kumar et al. ("Kumar"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See* MPEP § 2131, for example. Applicant submits that Kumar fails to teach each and every element recited in claims 1, 3, 4, 6, 7, 9-11, 18, 19, 22-25, 27, 29, 30 and 38 and thus they define over Kumar.

Applicant respectfully submits that claims 1, 3, 4, 6, 7, 9-11, 18, 19, 22-25, 27, 29, 30 and 38 define over Kumar. As correctly noted in the Office Action on page 10, Kumar fails to teach "comparing a value of the remote discovery register with the aggregation discovery code." Applicant respectfully submits that independent claims 1, 4, 6, 10, 18, 29 and 38 have been amended to recite limitations similar to "comparing a value of the remote discovery register with the aggregation discovery code." Accordingly, Applicant respectfully submits that Kumar fails to teach, suggest or disclose each and every element recited in the independent claims and requests removal of the anticipation rejection with respect to claims 1, 4, 6, 10, 18, 29 and 38. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 3, 7, 9, 11, 19, 22-25, 27 and 30, which depend from independent claims 1, 4, 6,

10, 18, 29 and 38 respectively and, therefore, contain additional features that further distinguish these claims from Kumar.

35 U.S.C. § 103

At page 7, paragraph 3 of the Office Action claims 2, 5, 8, 12 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of USPPN 2004/0068686 to Palm ("Palm"). At page 9, paragraph 4 of the Office Action claims 13, 14, 16, 20, 26, 28 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Nguyen. At page 12, paragraph 5 of the Office Action claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Nguyen and further in view of Palm. At page 13, paragraph 6 of the Office Action claims 32-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar in view of Palm and Nguyen. At page 16, paragraph 7 of the Office Action claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kumar. Applicant respectfully traverses the rejections, and requests reconsideration and withdrawal of the obviousness rejections.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching

or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 2, 5, 7-8, 12-17, 20, 26, 28, 31-37 and 39. Therefore claims 2, 5, 7-8, 12-17, 20, 26, 28, 31-37 and 39 define over the cited references whether taken alone or in combination. For example, claim 16 recites the following language, in relevant part:

comparing a value of the remote discovery register to the aggregation discovery code....

As correctly noted in the Office Action, the above-recited language is not disclosed by Kumar. According to the Office Action, the missing language is disclosed by the Nguyen at column 10, lines 25-32 and 42-45. Applicant respectfully disagrees.

Applicant respectfully submits that Nguyen fails to disclose the missing language of the claimed subject matter. For example, Nguyen at the given cite, in relevant part, states:

The source address, extracted from the message sent by the BWC 14, is used as the host ID index to search the Channel.sub.database. 2. If there is a record in the Channel.sub.database that corresponds to the host ID and the Destination ID respectively extracted from the source address and the destination address of the BWC request, the BWM 12 performs the following actions ... if the received

message is a bandwidth de-allocation message: i. the BWM
updates the Channel.sub.database accordingly....

By way of contrast, the claimed subject matter teaches “comparing a value of the remote discovery register to the aggregation discovery code....” Applicant respectfully submits that this is different than the above recited teaching of Nguyen.

Applicant respectfully submits that Nguyen at column 10, lines 1-5 describes the Host ID as

[A] unique data link layer address...which is used as the key attribute for records in the database. The Host ID also represents one end of a channel, the sender.

Applicant respectfully submits that he has been unable to locate, in the cited portion of Nguyen, any teaching directed to “comparing a value of the remote discovery register to the aggregation discovery code....” Applicant respectfully submits that matching a source address and a destination address, as arguably taught by Nguyen at the given cite, is different than the above recited language of claim 16. Therefore, Nguyen fails to disclose, teach or suggest the missing language. Consequently, Kumar and Nguyen, whether taken alone or in combination, fail to disclose, teach or suggest every element recited in claim 16.

Moreover, Applicant respectfully submits that Palm also fails to teach, suggest or disclose the missing language. Therefore, Applicant respectfully submits that the cited references, taken alone or in combination, fail to teach, suggest or disclose each and every element recited in independent claim 16. Furthermore, Applicant respectfully submits that independent claims 1, 4, 6, 10, 13, 18, 29, 32 and 38 have been amended to

recite features similar to those recited in claim 16. Therefore, Applicant respectfully submits that claims 1, 4, 6, 10, 13, 18, 29, 32 and 38 are not obvious and are patentable over the cited references for reasons analogous to those presented with respect to claim 16.

Furthermore, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *See* MPEP § 2143.03, for example. Accordingly, removal of the obviousness rejection with respect to claims 1, 4, 6, 10, 13, 16, 18, 29, 32 and 38 is respectfully requested. Claims 2, 5, 7-8, 12, 14-15, 17, 20, 26, 28, 31, 33-37 and 39 also are non-obvious and patentable over the cited references, taken alone or in combination, at least on the basis of their dependency from claims 1, 4, 6, 10, 13, 16, 18, 29, 32 and 38 respectively. Applicant, therefore, respectfully requests the removal of the obviousness rejection with respect to these dependent claims.

For at least the reasons given above, claims 1-39 are non-obvious and represent patentable subject matter in view of the cited references, whether taken alone or in combination. Accordingly, removal of the obviousness rejection with respect to claims 1-39 is respectfully requested. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken

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alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

It is believed that claims 1-39 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-9338 to discuss any matter concerning this application.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to deposit account 50-4238.

Respectfully submitted,

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John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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